

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow.

Claims 1 - 27 are pending in the application.

By the above amendments, Claims 1, 21, 24 and 27 have been amended to read, in part, ". . . smoke produced upon combustion/pyrolysis . . . in the electrical smoking system." These amendments do not narrow the intended scope of Claims 1, 21, 24 and 27 since "the smoking article" in Claim 1 and "the cigarette" in Claims 21, 24 and 27 are recited in the preambles of these claims. Applicants have also rewritten Claims 2, 22 and 25 in independent form.

Applicants thank the Examiner for acknowledging that Claim 26 would be allowable if a Terminal Disclaimer is filed with respect to U.S. Patent No. 6,289,898 and that Claims 2, 4, 12-13, 15-17, 22, 23 and 25 would be allowable if rewritten to include the limitations of the base claim and any intervening claims and if the Terminal Disclaimer is filed with respect to the '898 patent. Applicants respectfully submit that in view of the foregoing amendments, the following remarks and a Terminal Disclaimer to be submitted in due course, all pending claims in the application will be in condition for allowance.

Turning now to the Official Action, Claims 1-27 stand rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-17 of U.S. Patent No. 6,289,898. Although Applicants do not acquiesce in the rejection, in order to obviate this

rejection, Applicants will provide a suitable Terminal Disclaimer to obviate this ground of rejection.

Claims 1, 3, 5-6, 14, 18, 21, 24 and 27 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by McCarty (U.S. Patent No. 3,744,496). The reasons for the rejection are stated at page 3 of the Official Action. For at least the reasons that follow, withdrawal of the rejection is in order.

Claim 1, as amended above, recites a wrapper for a smoking article of an electrical smoking system wherein tobacco is contained by the wrapper, the wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in the smoke produced upon combustion/pyrolysis of the smoking article in the electrical smoking system. (Emphasis added).

Claim 21, as amended above, recites a cigarette of an electrical smoking system comprising a tobacco rod contained by a paper wrapper and an optional filter at one end of the cigarette, the paper wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in the smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system. (Emphasis added).

Claim 24, as amended above, recites a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web and an optional filter at one end of the cigarette, the paper wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce

the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system. (Emphasis added).

Claim 27, as amended above, recites a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web, and an optional filter at one end of the cigarette, the tobacco web comprising tobacco and at least one filler therein, the filler being effective to reduce the content of gaseous components and mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system. (Emphasis added).

The Official Action takes the positions that “McCarty discloses all that is recited in the claims” and that “claims containing recitation with respect to the manner in which the claimed apparatus is intended to be employed (i.e., “in an electrical smoking system”) does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.” (See Official Action at page 3.)

McCarty relates to smoking articles such as cigarettes, cigars and the like, and the wrapper for the tobacco column thereof, and more particularly to a wrapper for such smoking articles which when used either by itself or as an inner liner in combination with conventional wrappers is intended to significantly reduce particulate and vapor phase constituents in the smoke drawn through the smoking article as well as reduce the amount of visible sidestream smoke that normally emanates therefrom. (See McCarty at column 1, lines 5-14.)

It is well established that in order to demonstrate anticipation under §102(b), each element of the claim at issue must be found, either expressly described or under the principles of inherency, in the single prior art reference. See Kalman v. Kimberly-Clark Corp., 218 USPQ 789 (Fed. Cir. 1983). That is not the case here.

For example, McCarty discloses using a carbon filled wrapper for the tobacco column of a cigarette, cigar or similar smoking article for purposes of reducing the quantity of organic vapor phase components and reducing the visible sidestream smoke from the cigarette or cigar. (See McCarty, for example, at column 2, lines 9-19.) McCarty discloses that the carbon filled paper is preferably used in an inner wrap under a normal outer wrap for the tobacco column on the cigarette or cigar. (See McCarty, for example, at column 2, lines 36-38.) McCarty also discloses that if the carbon filled wrapper is used with or without the addition of commonly used cigarette paper or cigar wrap burning chemicals such as alkali metal hydroxides, bicarbonates and carbonates, that burning retardants can be used in combination with the carbon filler to modify the combustion properties of the wrapper. (See McCarty at column 3, lines 10-24.) McCarty further discloses that alkaline earth metal carbonate such as calcium or magnesium carbonate may be included as an additional filler material in the wrapper stock and that other commonly known burning chemicals can be used such as citrate, phosphate and nitrate salts. (See McCarty at column 3, lines 17-31.) Accordingly, McCarty fails to disclose or suggest a wrapper for a smoking article of an electrical smoking system, wherein the wrapper compromises a filler being effective to reduce the content of gaseous components in the

smoke produced upon combustion/pyrolysis of the smoking article in the electrical smoking system, as defined in Claim 1, or a cigarette of an electrical smoking system comprising a filler being effective to reduce the content of gaseous components in smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system, as defined in Claims 21, 24, and 27.

Specifically, Applicants submit that the phrase "of an electrical smoking system" in the preamble of Claims 1, 21, 24 and 27 patentably distinguishes the claimed wrapper and cigarettes from the wrapper and cigarettes disclosed in McCarty. That is, because the subject claims, as amended above, include the words "in the electrical smoking system," Applicants submit that it is clear that the wrapper and cigarettes claimed are adapted for an electrical smoking system rather than a conventional cigarette, cigar or smoking article, as disclosed in McCarty.

In this regard, Applicants note that courts have established that when the preamble gives life and meaning to the claimed invention, then its limitations do limit the scope of the claim. See Loctite Corp. v. Ultraseal, Ltd., 781 F.2d at 866, 288 USPQ at 92; Perkin-Elmer Corp. v. The Computer Vision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984). Furthermore, courts have found claim preambles to be limiting when the introductory phrase was deemed essential to point out the invention defined by the claim" See Kropa v. Robie, 187 F.2d 888, 150 USPQ 478, 481 (CCPA 1951). As the phrases "effective to reduce the content of the gaseous components in the smoke produced upon combustion/pyrolysis of the smoking article in the electrical smoking system" and

"effective to reduce the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system," clearly define the filler of the claimed wrapper and cigarettes as one that is effective to reduce the content of gaseous components in smoke produced in an electrical smoking system, as recited in the preamble of these claims, Applicants submit that the preambles of these claims point out the invention defined therein and, thus, gives life and meaning to the claimed invention.

Additionally, Applicants note that courts have held the preamble of a claim to be limiting when the claim expressly incorporates language of the preamble into the body of the claim. See, for example, CFMT, Inc. v. Yeldup International Court, 92 F. Supp. 2d 359 (D. Del. 2000). In the present application, the preamble of Claims 1, 21, 24 and 27 originally recited a smoking article or cigarette of an electrical smoking system and the body of each claim originally referred back to "the smoking article" or "the cigarette". Thus, while the preambles of the original claims already breathed life and meaning into the body of the claims, Claims 1, 21, 24 and 27, as amended, all further refer to the electrical smoking system recited in the preamble again in the body of each claim. Thus, Applicants submit that the preamble language of these claims cannot be ignored under applicable legal precedent.

In addition to being distinguished on the basis of the claimed wrapper's and cigarettes' filler being one that is effective to reduce the content of gaseous components in smoke produced by an electrical smoking system, the cigarette defined in Claims 24 and 27 is further distinguished from the cigarettes disclosed in McCarty, because the cigarettes of

Claims 24 and 27 include a tobacco web. As the smoking articles described in McCarty are conventional smoking articles that do not include a tobacco web, Applicants submit that Claims 24 and 27 further patentably distinguish the claimed invention over McCarty.

For at least the above reasons, Applicants respectfully submit that Claims 1, 21, 24 and 27 are patentable over McCarty. The remaining Claims (3, 5-6, 14 and 18) depend, either directly or indirectly, from independent Claim 1 and are therefore also patentable over McCarty for at least the reasons that claim 1 is patentable.

Claims 7-11 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over McCarty. The reasons for the rejection are stated at page 4 of the Official Action. For at least the reasons that follow, withdrawal of the rejection is in order.

As Claims 7-11 and 19 all depend directly or indirectly from independent Claim 1, Applicants submit that Claims 7-11 and 19 are also patentable over McCarty for at least the reasons that Claim 1 is patentable thereover. Applicants respectfully request withdrawal of this ground of rejection.

Claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over McCarty in view of Baldwin (U.S. Patent No. 5,263,500). The reasons for the rejection are stated at page 5 of the Official Action. For at least the reasons that follow, withdrawal of the rejection is in order.

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be

considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385; 165 USPQ 494, 496 (CCPA 1970). See M.P.E.P. § 2143.03.

As Claim 20 depends from Claim 1, Claim 20 necessarily includes all of the limitations of Claim 1. Thus, Claim 20 is patentable over McCarty for at least the reasons that Claim 1 is patentable thereover.

Baldwin relates to a paper wrapper construction for use in conjunction with a smoking article, such as a cigarette. Specifically, the paper wrapper of Baldwin is intended to alter the characteristics of the smoking article including burn rate, puff count and tar delivery with the use of fine particle size calcium carbonate as a mineral filler. (See Baldwin at column 1, lines 5-13.)

Baldwin, however, does not overcome the above deficiencies of McCarty. That is, like McCarty, Baldwin also fails to disclose or suggest a wrapper or a smoking article of an electrical smoking system, wherein the wrapper or smoking article comprises a filler being effective to reduce the content of gaseous components in smoke produced upon combustion/pyrolysis in the electrical smoking system, as defined in Claim 1. Thus, the combination of McCarty and Baldwin fails to disclose or suggest all of the claim limitations.

Furthermore, the combination of McCarty in view of Baldwin does not reflect a proper consideration of “all words” in the claim (including all of the words of Claim 1, from which Claim 20 depends). In particular, because neither of the cited references discloses or suggests a wrapper for an electrical smoking system, Applicants submit that the

Official Action has not given full consideration to all claim limitations, i.e., patentable weight must be given to "of an electrical smoking system" and "effective to reduce the content of gaseous components ... in the electrical smoking system" in Claim 1 in judging the patentability of Claim 20 over McCarty and Baldwin.

For at least these reasons, Claim 20 is patentable over the combination of McCarty in view of Baldwin. Applicants respectfully request reconsideration and withdrawal of the rejection.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 7, 2003

By: _____


Peter K. Skiff

Registration No. 31,917

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620